

27-FEB-2003 12:38PM

FROM-Gen-Probe Incorporated - Patent Dept.

+1 858 410 8928

T-327 P.005/006 F-859

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Re Patent Application of:

ADAMS *et al.*

Serial No. 09/867,193

Filed: May 29, 2001

For: DECOY PROBES

Group Art Unit: 1634

Examiner: Chakrabarti, A.

Confirmation No. 7798

Atty. Docket No. GP100-03.CN1

VIA FACSIMILE

**COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE**

Box Issue Fee  
Commissioner for Patents  
Washington, D.C. 20231

Sir:

Applicants are submitting the following comments to address errors in the Examiner's statement of reasons for allowance mailed on February 13, 2003. First, it is noted that the Examiner characterized Applicants' claimed decoy probes to include, in one embodiment, a "non-nucleotide phosphorothioate linker" joining a first nucleotide base recognition sequence region to the 3' or 5' end of an optionally present second nucleotide base recognition sequence region. In response, Applicants wish to point out that the term "phosphorothioate" does not appear in the claims to describe the linker which may be included in the decoy probes, nor have Applicants defined non-nucleotide linkers to include phosphorothioates. Second, although the Examiner states that Kacian (U.S. Patent No. 5,554,516) does not teach or suggest joining a primer sequence to the 3' or 5' end of an RNA promoter sequence by means of a "non-nucleotide phosphorothioate linker," Applicants specifically note that the primer sequence of Kacian is joined directly to the promoter sequence, and that it is the 3' end of the promoter sequence that can be blocked with, *inter alia*, a phosphorothioate or a non-nucleotide. See Applicants Reply dated January 8, 2003. Applicants additionally observe that the Examiner's recitation of the limitations of the claims is not complete; however, it is not believed that the particular omissions of the Examiner require commentary here.

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## COMMENTS

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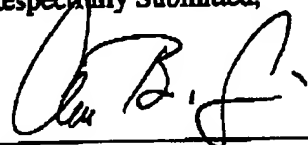
Certificate of Transmission

I hereby certify that this correspondence (and any referred to as attached) is being sent by facsimile to 703-746-4000 on the date indicated below to Box Issue Fee, Commissioner for Patents, Washington, D.C. 20231.

Respectfully Submitted,

Date: February 27, 2003

By:



Charles B. Cappellari  
Registration No. 40,937  
Attorney for Applicants

GEN-PROBE INCORPORATED  
Patent Department  
10210 Genetic Center Drive  
San Diego, California 92121  
PH: 858-410-8927  
FAX: 858-410-8928